

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**APPELLANT:** Bradley S. Templeton

**SERIAL NO.:** 09/416,278

**FILING DATE:** October 14, 1999

**TITLE:** Method and Apparatus for Intermediation of Meetings  
and Calls

**EXAMINER:** Beth (Van Doren) Boswell

**GROUP ART UNIT:** 3623

**ATTY. DKT. NO.:** 5338.01 (SMC)

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**REPLY BRIEF**

Sir:

This Reply Brief is submitted in response to the Examiner's Answer mailed on March 13, 2009 and timely filed within two months thereof.

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Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being communicated via the USPTO EFS electronic filing system from Palo Alto, Calif. on May 7, 2009.

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### **Status of Claims**

Claims 92 and 96 were rejected under 35 U.S.C. 112, second paragraph.

The Appellant noted in the Appeal Brief that both rejections had been overcome

5 through an Examiner interview, while the Examiner replied that the rejection of

claim 96 was maintained (Examiner's Answer page 2). Accordingly, the

Appellant addresses the rejection of claim 96 under 35 U.S.C. 112, second

paragraph, for the first time in this appeal, below.

### 10 **Rejection of Claim 96 under 35 U.S.C. §112, Second Paragraph**

Claim 96 was rejected under 35 U.S.C. §112, second paragraph as being

indefinite on the basis that there is insufficient antecedent basis in the claim for

the limitation "the phone." Claim 96 adds the limitation to claim 1 of "wherein the

requester R-A and target T-A are both available when they are both off of the

15 phone."

MPEP §2173.05(e) provides that "[a] claim is indefinite when it contains

words or phrases whose meaning is unclear. The lack of clarity could arise

where a claim refers to "said lever" or "the lever," where the claim contains no

20 earlier recitation or limitation of a lever and where it would be unclear as to what

element the limitation was making reference. Similarly, if two different levers are

recited earlier in the claim, the recitation of "said lever" in the same or

subsequent claim would be unclear where it is uncertain which of the two levers

was intended. A claim which refers to "said aluminum lever," but recites only "a lever" earlier in the claim, is indefinite because it is uncertain as to the lever to which reference is made. **Obviously, however, the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the**  
5 **scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.**" citing *Energizer Holdings Inc. v. Int'l Trade Comm'n*, 435 F.3d 1366, 77 USPQ2d 1625 (Fed. Cir. 2006) (emphasis added).

Even if the phone in claim 96 lacks explicit antecedent basis, this does not  
10 inherently render the claim indefinite. The question remains whether the scope of claim 96 would be **reasonably ascertainable** by those skilled in the art, and if so, then the claim is not indefinite. Here, the term "the phone" is not referring back to a particular phone recited earlier in the claim, but is being used in the context of the phrase "off of the phone" and one of ordinary skill would  
15 understand this. When two people are said to both be off of the phone, as in claim 96, it is generally accepted to mean that neither person is using a phone. It does not imply, in common usage, that both people were using the same phone, or were speaking to each other on a common phone line. The complementary phrases "on the phone" and "off the phone" are so ubiquitous in common usage  
20 that the Appellant believes that it not necessary to introduce affidavits or other evidence to demonstrate that the scope of claim 96 would be reasonably ascertainable by those skilled in the art from the context in which "the phone" is used.

## **Responses to the Examiner's Answers**

### **Rejections of Claims 88-89 and 91 under 35 U.S.C. §102(e) over Gisby**

**whether conditional language was properly ignored as not limiting**

5                   **the scope of the claims**

The claims at issue were rejected as being anticipated by Gisby owing to a determination by the Examiner that a limitation, though recited, was not limiting. The limitation that was deemed to be non-limiting is not found in Gisby. The Examiner has not made an alternative rejection of these same claims under 35  
10 U.S.C. §103 to explain why the missing limitation would nevertheless be obvious to add to Gisby, although the Examiner has had two opportunities to do so. The Appellant submits that if the limitation is found by the Board to limit the scope of the claims at issue, then these claims are neither anticipated by, nor obvious in view of, Gisby.

15

It is the Appellant's position that Examiner has misapplied MPEP §2111.04 in reaching the determination that the limitation does not limit the claims. First, MPEP §2111.04 does not properly apply to conditional claim limitations. Secondly, even if the section does apply to conditional claim  
20 limitations, the Examiner did not follow the guidance provided by the cited cases in MPEP §2111.04 to determine whether the claim language at issue limits or does not limit claim scope.

Turning to the first point, the Appellant in the Appeal Brief asserted that the claim language at issue is conditional language, and not optional language of the type that sometimes follows terms like “adapted to,” “wherein,” and “whereby.” The Appellant noted the very large number of issued patents that use conditional language of this type as further support. Although the Examiner acknowledged that the Appellant was making this argument (“Appellant disagrees that conditional language is equivalent to optional language” (Examiner’s Answer page 20)) the distinction between conditional and optional language was never squarely addressed. Rather, the Examiner stated that “[w]hen performing the process, only one of the “if” statements can occur since it is not possible to satisfy that a requestor is both available and unavailable at the same time. Thus, when properly construing the claim scope, only one if statement can limit the claim language in a given implementation.” (Examiner’s Answer page 23).

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The Appellant stands by the assertion that the distinction between conditional and optional is legitimate, and further asserts that the Examiner’s logic is based on a false premise, namely, that to have both if statements limit the claim requires the requestor to be both available and unavailable *at the same time*. To the contrary, the claims argued here do not make such a requirement. In claim 88, for example, the step of “if the requester is unavailable, then waiting until a time the requestor becomes available” can occur before the step of “if the requestor is available, then initiating the first real-time meeting.” Here, the

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requestor is first unavailable and then available. Clearly, the requestor does not have to be available and unavailable at the same time to have both if statements limit claim 88.

5           In summary, the Appellant has asserted that the claim language at issue is legitimate conditional language, and not optional language that does not limit claim scope pursuant to MPEP §2111.04. The Examiner did not address the distinction between conditional and optional language, but instead presented an argument that one of the two if statements must be optional based on the false  
10       premise that the claims require an absurdity otherwise. The Appellant has shown that the claims at issue do not require such an absurdity. Thus, both if statements properly limit the claims.

          Moreover, MPEP §2111.04 cites two cases for guidance in determining  
15       whether language can be construed as optional and not limiting. The Examiner did not follow this guidance. In *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005), the court held that when a “‘whereby’ clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention.” Although the claim language at  
20       issue here does not involve a whereby clause, the basic premise remains that a *condition that is material to patentability cannot be ignored in order to change the substance of the invention*. Here, the condition that requires waiting if the

requester is unavailable is both material to patentability and, if ignored, changes the substance of the claimed invention.

On the other hand, the court noted (quoting *Minton v. Nat'l Ass'n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)) that a “whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.”

Clearly, this is not the case with the method claims at issue. The limitation “if the requester is unavailable, then waiting until a time the requestor becomes available” does not simply express the intended result of a process step positively recited. Therefore, this limitation ought to be given patentable weight.

The Appellant also wishes to point out that if the Examiner is correct that only one if statement can be limiting and that the other if statement must be ignored, then the Examiner has not provided a logical basis for choosing to ignore the step of “if the requester is unavailable, then waiting until a time the requestor becomes available” over the step of “if the requestor is available, then initiating the first real-time meeting.” The reality, of course, is that Gisby does not teach or suggest waiting until a time when the requestor becomes available if the requester is unavailable, and had the Examiner instead ignored the step of “if the requestor is available, then initiating the first real-time meeting” then the anticipation rejection falls apart and the claims are allowable. As just noted, however, a condition that is material to patentability cannot be ignored in order to

change the substance of the invention. While the Appellant stands by the position taken in the Appeal Brief that all of the claim limitations must be considered, if the Examiner is correct to ignore one if statement, then it certainly should not be the one that is material to patentability and the one that if ignored  
5 would change the substance of the invention.

**whether the Examiner has properly interpreted the claim terms**  
**“requestor becomes available” and “becomes available.”**

The Appellant argued in the Appeal Brief that the Examiner has  
10 interpreted the claim terms “requestor becomes available” and “becomes available” overly broadly so that these limitations can be met by the method of Gisby when a caller moves to the top of a call center’s queue, thus becoming “accessible” to the agent taking calls from the queue. Under the Examiner’s interpretation, the caller is not available before the caller moves to the top of the  
15 queue but “becomes available” upon reaching the top of the queue. The Appellant’s position is that the caller in Gisby is always ready to talk and is therefore continuously available regardless of position in the queue. Thus, the disagreement centers on the meaning of “available.”

20 Per MPEP §2111.01 “[i]f extrinsic reference sources, such as dictionaries, evidence more than one definition for the term, the intrinsic record must be consulted to identify which of the different possible definitions is most consistent with applicant’s use of the terms. *Brookhill-Wilk 1*, 334 F. 3d at 1300, 67 USPQ2d



at 1137.” “Available” is a term with more than one definition. For example, Webster’s New Universal Unabridged Dictionary, Deluxe Second Edition, 1979, provides four definitions of which the first two are:

1. capable of being used; usable; as, *available* resources.
- 5        2. that can be got, had, or reached; handy; accessible.

In the Appeal Brief the Appellant asserted that the interpretation of the term “availability” in the present context means that a party has the ability and/or desire to engage in a meeting. In other words, the party is ready for a meeting, which is consistent with the first definition. The Examiner, on the other hand, has sought to frame the interpretation from the point of view of the agent such that “available” means “accessible” as in “turns out to be accessible to” the agent (Examiner’s Answer page 24).

15        Since extrinsic reference sources, such as dictionaries, evidence more than one definition for the term “available,” the intrinsic record **must** be consulted to identify which of the different possible definitions is most consistent with the Appellant’s use of the term. In the Examiner’s Answer the Examiner notes that “the Appellant relies heavily on the specification” (Examiner’s Answer page 23) and then quotes that “although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims” citing *In re Van Geuns* 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Although the Examiner here has acknowledged that “the claims are interpreted in light of

the specification” the Examiner has not indicated that the specification was in any way consulted in the interpretation of these terms. The Examiner concludes that “the interpretation...meets the broadest reasonable interpretation of the claim” (Examiner’s Answer page 24) but drops the “consistent with the specification” language imposed by the Federal Circuit’s *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) noted in MPEP §2111. Clearly, the Examiner has sought to avoid consulting the specification to form an interpretation of the claims even though the intrinsic record must be consulted.

10           The Appellant relied on the specification in the Appeal Brief to illustrate that, of the different possible definitions of “available,” the definition being advanced was more consistent with the Appellant’s use of the term than the definition being advanced by the Examiner. Although the Examiner has acknowledged the existence of the specification, the Examiner has so far refused  
15   to acknowledge that the broadest reasonable interpretation must be consistent with the specification. The Examiner also has not provided any argument why the interpretation of “available” as “accessible” is reasonable in view of the specification. The Examiner’s argument seems to be that the interpretation of “available” as “accessible” is not unreasonable when the claim is read in view of  
20   Gisby.

          The Appellant notes two other extrinsic sources that support the Appellant’s definition of “available” as having the ability and/or desire to engage

in a meeting, in effect, ready for a meeting. First, the Examiner admits that “[t]he term availability, in its broadest reasonable interpretation, is *ready for use or service*.” (Examiner’s Answer page 25, emphasis added). Also, the first two definitions of “available” provided by Dictionary.com

5 (http://dictionary.reference.com/browse/available) are:

1. suitable or ready for use; of use or service; at hand: *I used whatever tools were available*; and

2. readily obtainable; accessible: *available resources*.

10           Given the primary definition of “available,” clearly the callers in the queue of Gisby, whether or not at the top of the queue, are all available. These callers are all waiting, *ready* to speak with an agent. The agent may not be available, but the callers are. It follows that when a caller is elevated to the top of the queue the caller does not then become available since the caller was available  
15 the entire time that the caller was waiting in the queue. Accordingly, it should be clear that when a caller attains the top of the queue in Gisby this does not read on claim limitations such as the “requestor becomes available.”

          Rather than looking to the specification to determine the proper  
20 interpretation of the term “available,” the Examiner has instead advanced the argument that the Appellant is somehow reading limitations into the claim, although the Examiner has not identified the alleged limitations. The Examiner

has stated “that the claim does not specify the perspective of the claim” and “[t]he claim further does not recite how one becomes available or how availability is detected” (Examiner’s Answer page 24) but fails to link these assertions to either the Appellant’s prior arguments or to any alleged limitations being read into the claims.

The Appellant traverses the argument that limitations are somehow being impermissibly read into the claims. The court in *In re Prater* (415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)) explained that “reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.” In the case of *In re Prater* “the claim did not explicitly set forth the machine” and “the court found that applicant was advocating ... the impermissible importation of [the machine] from the specification into the claim” (MPEP §2111).

The MPEP provides a number of other examples. MPEP §2111.01 notes *In re Zletz*, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) in which “the examiner and the Board had interpreted claims reading ‘normally solid polypropylene’ and ‘normally solid polypropylene having a crystalline polypropylene content’ as being limited to ‘normally solid linear high homopolymers of propylene which have a crystalline polypropylene content’ [and]

[t]he court ruled that limitations, not present in the claims, were improperly imported from the specification.” MPEP §2145(VI) notes *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993) in which “[c]laims to a superconducting magnet which generates a ‘uniform magnetic field’ were not limited to the degree of magnetic field uniformity required for Nuclear Magnetic Resonance (NMR) imaging.” MPEP §2145(VI) also notes *Ex parte McCullough*, 7 USPQ2d 1889, 1891 (Bd. Pat. App. & Inter. 1987) in which the “[c]laimed electrode was rejected as obvious despite assertions that electrode functions differently than would be expected when used in nonaqueous battery since ‘although the demonstrated results may be germane to the patentability of a battery containing appellant’s electrode, they are not germane to the patentability of the invention claimed on appeal.’”

All of the cited examples seek to introduce one or more terms into the claims from the specification, a machine [*In re Prater*], linear high homopolymers having a crystalline polypropylene content [*In re Zletz*], the degree of magnetic field uniformity required for NMR [*In re Van Geuns*], and a battery [*Ex parte McCullough*]. By contrast, the Appellant here seeks to properly interpret limitations already explicitly recited in the claims.

20

Lastly, one may argue, although the Examiner has not, that the Appellant seeks to import from the specification “for the meeting” into the claims as in “if the requester is unavailable for the meeting, then waiting until a time the requestor

becomes available for the meeting.” The Appellant notes, however, that “the meeting” is already in the claims as in “a first request for a first real-time meeting between a requestor and a first target,” and “if the requestor is available, then initiating the first real-time meeting” as in claim 88. Clearly, that the availability or  
5 unavailability of the requestor pertains to the readiness of the requestor for the meeting cannot be in doubt. Again, it follows that when a caller in Gisby moves to the top of the queue the caller does not then “become available” since the caller was already available. By the Examiner’s own definition of “available” the callers in positions below the top of the queue are available, even though the  
10 Examiner would treat them as not available until at the top of the queue for the purposes of rejecting these claims. Thus, elevating a caller to the top of the queue in Gisby does not read on the limitation of a requestor becoming available and therefore the claims at issue are not anticipated.

15 **Rejections of Claims 1, 3-8, 54-55, 72-79, 81-82, 84-85 and 87 under 35**

**U.S.C. §103(a) over Gisby in view of Yacenda**

**whether the Examiner has properly interpreted the claim terms**

***“availability status.”***

The arguments presented above with respect to the interpretation of  
20 “available” are equally applicable here. In the argument above the Appellant noted that the Examiner’s argument seems to really be that the interpretation of “available” as “accessible” is not unreasonable when the claim is read in view of Gisby. The Examiner actually supports this conclusion in the response to the

present argument, stating that “[t]his is a consistent interpretation based on the art rejection below.” (Examiner’s Answer page 25). Clearly the Examiner does not consult the specification to interpret terms, but instead bases interpretation on the cited art.

5

**whether there is a motivation to combine the art as required to  
establish a *prima facie* case for rejection under 35 U.S.C.  
103(a)**

The Appellant continues to stress that there is no motivation to modify  
10 Gisby according to the teaching of Yacenda so as to read on the claims at issue. Gisby teaches a call waiting queue 69 (see FIG. 3) in which each register includes a priority value based on a priority determination (col. 5 lines 28-31). The Examiner equates the priority value to the availability status of the present claims (Examiner’s Answer page 7) and explains that it would be obvious “to  
15 include the call back feature of Yacenda et al. in the system of Gisby et al. in order to more efficiently facilitate calls between users by eliminating ‘phone tag’ situations and causing a user to be on hold for long periods of time.” (Examiner’s Answer page 9).

20 Without acceding to the Examiner’s position that there would be a benefit to Gisby that would be realized by adding the call back feature of Yacenda, the Appellant asserts that simply adding the call back feature of Yacenda would not, by itself, read on the claims at issue unless a still further modification were made

such that, in addition to the numerical values (1-10) assigned to the registers of the queue 69, it were also possible to assign a value of “unavailable” to a register. Only then would the combination teach the limitation “where a possible availability status includes not available.” This could be represented by

5    modifying the queue 69 in FIG. 3 of Gisby as shown below:

<u>Call Waiting Queue (FIFO)</u>						
1	2	3	4	5	6	7
10	9	9	8	Unavailable	3	1
<u>Priority Assignment</u>						

The Appellant believes that there is no motivation to assign the value of “unavailable” to a register of the queue 69 in Gisby even if the call back feature of Yacenda is itself, *arguendo*, obvious to add. Yacenda teaches a call back

10    feature in which the calling party leaves a call back number when the called party is not available. The called party can later call the calling party at the call back number, but the calling party may not be available at that time (col. 19 lines 44-45). In the proposed modified method of Gisby, until the point where the agent calls back the calling party using the call back number and finds that the calling  
15    party doesn’t answer, there is no reason to modify the priority assigned to the call in the queue 69. It is the Appellant’s position that once the agent determines that



the calling party doesn't answer the attempted call back, the priority for the call which has until this time been a numeric value (1-10), will not be set to "unavailable" since this does not specify a priority level that can continue to be ranked relative to other calls in the queue 69 as further calls are received. The

5 Appellant asserts that the most rational alternative, if the calling party doesn't answer the call back, is to drop the calling party from the queue 69 altogether. However, if the calling party is not dropped from the queue 69, then the most sensible alternative is to continue to associate the calling party with a numeric value to represent priority. A priority value of "unavailable" does not inform the

10 system of Gisby how to rank the calling party relative to other calling parties as the queue 69 is dynamically updated.

Accordingly, it is the Appellant's position that the system of Gisby, as proposed to be modified to incorporate the teaching of Yacenda, would not

15 overwrite the priority value in the queue 69 with "unavailable" but would retain some numeric priority value, in order to continue to rank the call relative to other received calls. If the Examiner is proposing something other than replacing numeric values in the queue 69 with the term "unavailable," it is unclear to the Appellant what is being proposed, or how the system of Gisby would handle a

20 calling party once it has been labeled "unavailable."

Furthermore, while Yacenda does teach that a calling party may be unavailable at the time of call back, Yacenda does not teach using the term

“unavailable” as any form of a status indicator for the calling party in the event that the calling party does not answer the call back. If the calling party is unavailable, Yacenda simply performs certain functions. Specifically:

5 If the ***calling party is unavailable***, then ***the computer queries the callback party*** to select between the "call back" and "message" functions (steps 1956). The PBX 10 also ***determines if the DND function has been activated*** (step 1963). If the DND function has been activated, then ***the PBX queries the callback party*** to select between the "call back" and "message" functions (step 1956). If the  
10 DND function has not been activated, ***the PBX establishes a telephone connection*** between the called party and the telephone nearest the location of the calling party (step 1964). (col. 19 lines 44-54).

15 In short, Yacenda teaches that a calling party can leave a call back number, that the calling party may be unavailable when called back, and if so, further functions can be triggered (querying the callback party, determining if the DND function has been activated or establishing a telephone connection). None of these triggered functions include designating a “status” of the calling party as  
20 “unavailable.” Even if it were obvious to adapt Gisby to allow a calling party to leave a call back number, and if the calling party fails to answer when an agent tries to return the call, the teaching of Yacenda does not suggest that it would be obvious to then either overwrite a priority value in the queue 69 with “unavailable” as illustrated above, or in any other way associate the term “unavailable” with the  
25 calling party.

**whether the Examiner has properly interpreted the claim term**

**“polled” as recited in claims 3 and 5.**

In rejecting claim 3 the Examiner suggested that the polling of target T-A is taught by a teaching of “column 5, lines 5-11, wherein the system knows if the target is logged in and busy.” In response to the Appellant’s arguments that the cited art does not teach polling, the Examiner states “the term poll means to  
5 survey in the broadest reasonable interpretation of the term.” The Appellant traversed, arguing that the term “polled” is an art-recognized term with a meaning in the art that is different than the standard dictionary definition applied by the Examiner. The Appellant offered two definitions from dictionaries in the field of art, but the Examiner refused to consider the definitions, observing that the  
10 “references post date the filing of this application” (Examiner’s Answer page 27). The Examiner also referred again to reading limitations from the specification into the claims. (Examiner’s Answer page 27).

As was the case above with the term “available,” this is not an instance  
15 where the Appellant is trying to impermissibly import a limitation from the specification, and the Examiner has not identified any such limitation, but rather an instance where the Appellant is trying to help the Examiner interpret a limitation explicitly recited in the claim as would one of ordinary skill in the art.

20 According to MPEP §2111.01(II), the ordinary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art.

*Phillips v. AWT Corp.* The court in *Phillips* explained:

We have especially noted the help that technical dictionaries may provide to a court “to better understand the underlying technology”

and the way in which one of skill in the art might use the claim terms. Vitronics, 90 F.3d at 1584 n.6. Because dictionaries, and especially technical dictionaries, endeavor to collect the accepted meanings of terms used in various fields of science and technology, those resources have been properly recognized as among the many tools that can assist the court in determining the meaning of particular terminology to those of skill in the art of the invention. See Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1325 (Fed. Cir. 2002). Such evidence, we have held, may be considered if the court deems it helpful in determining “the true meaning of language used in the patent claims.” Markman, 52 F.3d at 980. (*Phillips*, 75 USPQ 1321, 1330)

The Appellant introduced definitions from technical dictionaries to show the meaning of “polling” as used by those of skill in the art. The Examiner discounted the evidence as being from references that post date the filing of this application. While the Appellant asserts that the definition of “polling” did not change in the short span between the filing of this application and the time of publication of the technical dictionaries, the Appellant nevertheless supplies herewith a definition of polling from yet another technical dictionary, Telephony’s Dictionary, Second Edition, 1986, which defines polling as:

The process by which a processor invites one of several external units to feed it with information. The initiative for the transfer of information rests with the processor.

This further definition is also provided merely for the purposes of example. However, like the previously offered definitions, this definition characterizes polling as a process whereby a system, a processor in this definition, actively seeks inputs rather than passively waiting for inputs. The Examiner seeks to use the non-art specific definition of “surveyed, checked, or examined” (Examiner’s Answer page 27) to then assert polling is met by certain monitoring functions

taught by Gisby (Examiner's Answer page 28). Gisby provides "[t]he CTI application monitors switch 21 for incoming calls to a routing or call-distribution point. The status of telephones at agent stations is also monitored" (col. 5 lines 4-7). "Monitoring" as used by Gisby would not inform one of ordinary skill in the art whether the CTI application is actually polling the switch 21 and/or the agent telephones or simply passively waiting for calls to come in from the switch 21 and passively waiting for agent telephones to be off-line.

Clearly, the Examiner has not made the argument that the CTI application of Gisby *inherently* polls the switch 21 and/or the agent telephones because such a determination requires that the Examiner show that "the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art" *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990, emphasis added). Per MPEP §2112, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic" citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

As was the case above with the term "available" the allegation that the Appellant is seeking to introduce limitations from the specification into the claims is a red herring. The Examiner has not identified any limitation in the specification that the Appellant is supposedly seeking to add to the claims, and the Appellant has shown that the term "polling" is an art-recognized term with an

ordinary meaning to a person of ordinary skill in the relevant art. Extrinsic evidence has been supplied to show the art-recognized meaning of “polling.” Even if monitoring may be performed by polling, the Examiner has not shown that the CTI application of Gisby *inherently* polls the switch 21 or the agent  
5 telephones, and therefore dependent claims 3 and 5 are further patentable over the combination of Gisby and Yacenda.

**whether the cited art teaches pushing of status information to the  
decider system by the Target T-A (claim 4) or by the party  
10 (claim 6).**

In rejecting claims 4 and 6 the Examiner suggests that the further limitations of both of these claims are taught by Gisby “wherein the system knows if the agent is busy based on status information established by the agent” (Examiner’s Answer page 10). Again, the Appellant offered a technical dictionary  
15 definition to show the ordinary meaning of “push” that would be understood by one of ordinary skill in the art.

In reply, the Examiner never offered a different definition, but merely noted that the supporting reference post dates the present application. The Examiner  
20 seems to recognize that “push” is an art-recognized term, since the Examiner did not offer a non-technical definition of “push,” and the Examiner did not argue that the definition of “push” that was provided was not the art-recognized definition at the time the present application was filed. The Examiner, however, did not show

that the reason the CTI application knows the agent is busy is because the status information is inherently pushed to the CTI application. As above, the fact that agents *may* push status information in Gisby is not sufficient to establish that agents *inherently* push status information. The Appellant notes that status  
5 information could be obtained by the CTI application without the agent pushing the status information, thus it cannot be that the status information is necessarily pushed by the agent. Therefore, dependent claims 4 and 6 are further patentable over the combination of Gisby and Yacenda.

10 It is worth noting that the Examiner has argued that the same discussion of monitoring in Gisby (col. 5 lines 5-11) teaches both polling and pushing, therefore it would appear to be impossible to say that either polling or pushing is taught inherently by Gisby.

15 **Rejections of Claims 56-57 and 80 under 35 U.S.C. 103(a) as being**  
**unpatentable over Gisby in view of Yacenda and in further view of**  
**Vaios**  
**whether there is a motivation to modify Gisby according to the**  
**teaching of Vaios**

20 The Examiner rejected claim 56 as unpatentable over a combination of Gisby and Vaios. The Appellant in the Appeal Brief argued that there was no motivation to make the proposed combination. The Appellant alleged that the proposed combination does not have a reasonable expectation of success, the

proposed modification would render Gisby unsatisfactory for its intended purpose, and that the proposed modification impermissibly changes the principle of operation of Gisby.

5           In rebuttal, the Examiner offered two sentences. The first sentence merely reiterated a portion of claim 56 (“Claim 56 recites that an availability status of the target T-A is displayed on the requester system, along with an indication that the requestor has requested a meeting with the target.” (Examiner’s Answer page 29)). The Examiner’s second sentence is directed to  
10   what the claim does not require (“In claim 56, it is not required that the user has specified a specific target (such as by name), but rather in the broadest reasonable interpretation the user would merely requested or asked for a meeting with some target and is waiting for the meeting to occur.” (Examiner’s Answer page 29)). The Appellant fails to see how reciting back a portion of the  
15   claim, and then arguing the scope of the claim, meaningfully addresses the Appellant’s argument about a lack of a motivation to make the proposed modification to Gisby.

          Further to the arguments made in the Appeal Brief, the Appellant would  
20   like to note that in the rejection of claim 56 the only modification the Examiner proposes to Gisby is the addition of “the requester side of these systems, wherein the requester may view status and other information about agents” yet the benefit that the Examiner asserts to flow from this addition is “to more



efficiently let the requester gain service in a more timely manner and to allow the requester to have greater control over the handling and routing of their calls.”

(Examiner’s Answer page 15). The Appellant asserts that these benefits would not derive from the proposed modification of Gisby, namely, to allow the

5 requestor to view information. The Examiner has not provided a motivation that ties to merely viewing status and other information about agents and therefore there is no motivation to make the *prima facie* case.

Turning to the two motivations advanced by the Examiner, first, the

10 Examiner asserts that making the modification would “let the requestor gain service in a more timely manner” (Examiner’s Answer page 15). The Appellant finds it difficult to accept that allowing the caller to view information would provide service in a more timely manner relative to the unmodified system of Gisby in which callers are matched to the first available agent according to each caller’s

15 assigned priority. In fact, Vaios explains that “instead of accepting the first available agent for the fastest service time, the caller may specify one or more preferred agents.” (col. 4 lines 44-46).

The other portion of Vaios the Examiner cites to for the motivation to make

20 the proposed modification also does not suggest that the disclosed system offers increased *timeliness* to callers, but instead merely opines that “rout[ing] calls more efficiently” is a desirable attribute for call centers (col. 1 lines 23-25).

Certainly no part of Vaios teaches or suggests that allowing the requester to view

status information has any impact on the timeliness with which service is rendered. It is apparent, therefore, that allowing the requester to merely view status and other information about agents does not lead to the first motivation offered by the examiner for making the modification, more timely service.

5

Second, the Examiner asserts that making the modification would “allow the requester to have greater control over the handling and routing of their calls.” (Examiner’s Answer page 15). The Appellant’s position is that it is plainly apparent that allowing the requester to merely view status and other information about agents does not provide the requester with greater control over the handling and routing of their calls. To have greater control requires some degree of control to begin with. Merely adding the ability to passively view information, as proposed by the examiner, does not allow the requester to have greater control over anything. It is also apparent, therefore, that allowing the requester to merely view status and other information about agents also does not lead to the second motivation offered by the examiner for making the modification, greater control over handling and routing of calls.

The Appellant also notes that if the Examiner is proposing to add still further teachings of Vaios to Gisby to provide, at least, for callers to queue up for multiple agents and so forth in order to justify the suggested motivation of greater control, and to date the Examiner has only sought to add the ability to allow the requester to view status and other information about agents, the Examiner would

need to explain how those further additions would come together. The Appellant summarizes the issues with such further modifications below.

Gisby teaches a single queue 69 in which callers are prioritized; Vaios  
5 teaches multiple queues per caller where each queue is specific to an agent or resource (there can be “two or more separate and distinct queues on behalf of the caller” (Vaios claim 2)). Gisby “maximizes efficiency of call centers” (Col. 3 lines 25-26) by prioritizing callers and automating the delegation of calls from a queue to agents according to priorities that are initially assigned to the calls. On  
10 the other hand, Vaios seeks to optimize the user experience as it is “self-routing” (Abstract) and provides “information [that] may include, for example, the background, capabilities or credentials of the human agents, and the specifications and location of hardware resources.” (Abstract). Vaios also “allows a customer to select multiple preferred agents and/or resources and initiate  
15 multiple calls.” (Abstract). It is not clear, and the Examiner has never offered an explanation regarding, how the combination of Gisby and Vaios would merge these very different architectures and philosophies. Adding multiple agent-specific queues to the system of Gisby would certainly impermissibly change the principle of operation of Gisby, as would allowing callers to route themselves,  
20 initiate multiple calls, and change and delete calls.

MPEP §2142 provides that “[t]he ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due

consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of ‘a preponderance of evidence’ requires the evidence to be more convincing than the evidence which is offered in opposition to it.”

5

Here, the evidence offered in support of the rejection is that “Vaios teaches displaying an availability status of the target T-A on the requestor system, along with an indication that the requestor has requested a meeting with the target” (Examiner’s Answer page 14), and that it would have been obvious to “*allow the requester system to view availability data and meeting requests by the requester in order to more efficiently let the requester gain service in a more timely manner and to allow the requester to have greater control over the handling and routing of their calls.*” (Examiner’s Answer page 15, emphasis added). As noted, more timely service is not a benefit provided by Vaios.

15 Further, the Examiner has not shown how allowing the requester system to view availability data and meeting requests would in any way make service more timely for callers. Being able to view a queue does not make the queue move any faster. The Examiner also has not explained how allowing the requester system to view availability data and meeting requests leads to the alleged benefit  
20 of greater control over handling and routing. These benefits in Vaios flow from allowing callers to perform tasks such as making selections and making multiple calls. Merely being able to view availability data and meeting requests does not provide callers with the benefit of greater control.

The evidence offered against the rejection is that Gisby and Vaios seek different objectives and are therefore very different fundamentally in their use of queues. The Examiner proposes what would appear to be a simple modification  
5 of Gisby to just allow the requester system to view availability data and meeting requests, but one of the two benefits the Examiner claims will flow from this modification (more timely service) Vaios expressly teaches is not a benefit, and the other (greater control) would only be realized by integrating further aspects of Vaios into Gisby. The Examiner has not addressed how these dissimilar  
10 systems could be further integrated to have both a prioritized queue and multiple queues per caller. Further, the Appellant has argued that there is no motivation to combine for reasons including that the proposed modification would impermissibly change the principle of operation of Gisby. The Examiner has not offered an adequate rebuttal, offering instead only a brief observation about claim  
15 scope.

Clearly, the evidence in support of the obviousness rejection of claim 56 is less convincing than the evidence which has been offered in opposition to it, and therefore the Appellant has demonstrated by a preponderance of evidence that  
20 claim 56 is patentable.

**Rejections of Claim 83, 86 and 90 under 35 U.S.C. 103(a) as being  
unpatentable over Gisby in view of Vaios**

**whether the cited art teaches all of the limitations of claim 83**

In the rebuttal argument regarding claim 83 the Examiner seems to  
5 suggest that because the claim was rejected under 35 U.S.C. §103, that  
therefore there is no longer a requirement to identify each and every limitation in  
the claim as being met by the proposed system of Gisby as modified by Vaios.  
(Examiner's Answer pages 30-31). Per MPEP §2143.03 "[a]ll words in a claim  
must be considered in judging the patentability of that claim against the prior art"  
10 citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Examiner professes not to understand how a common requestor to  
two meetings is not a party to both meetings. The Appellant explained in the  
Appeal Brief that if the requestor only attends one of the two meetings the  
15 requestor is only a party to the meeting that was actually attended, and Vaios  
teaches that only one meeting of the several queued meetings actually occurs.  
The Examiner seems to be making the argument that one is a party to everything  
one is invited to, whether or not one actually accepts the invitation.

20 The points made with respect to claim 56 about the lack of a motivation to  
combine Gisby with Vaios apply equally in this case. Here, the Examiner ties the  
same alleged benefits of more timely service and greater control to "allow[ing] the  
requester system to make a queue of outgoing calls while waiting for an agent"

(Examiner's Answer page 16). Not only does the Examiner not cite to support in Vaios for a specific teaching of "a queue of outgoing calls," the only reference to outgoing calls in Vaios is a statement about call centers generally, found in the background section, "[c]all centers are systems that enable a number of agents to handle incoming and/or outgoing calls." (col. 1 lines 10-11). The Examiner has not explained what constitutes "an outgoing queue" and how such a queue would be integrated with the system of Gisby or how a queue of outgoing calls would result in the alleged benefits of the combination.

As above, the evidence in support of the obviousness rejection of claim 83 is less convincing than the evidence which has been offered in opposition to the rejection, and therefore the Appellant has demonstrated by a preponderance of the evidence that claim 83 is patentable.

**Rejections of Claims 92-92 under 35 U.S.C. 103(a) as being unpatentable over Gisby et al. in view of Yacenda and in further view of Vardi**  
**whether the Examiner has failed to present a *prima facie* case for rejection under 103(a) because the prior art does not teach or suggest all the claim limitations**

In rebuttal to the rejection of claim 92 the Appellant argued that Vardi does not teach the limitation that the non-common requester R-A or R-B that is party to another distinct meeting request is a target in that meeting request, noting that

there is not a teaching of distinct meetings, but rather a teaching for conferencing two calls, hence a teaching of a single meeting. The Examiner replied Vardi in at least col 7 line 50 to col. 8 line 5 teaches “the requestor involves himself in another meeting while waiting for the other target to conference in. As the  
5 parties are different and the meeting occurs at a different time, the meeting is distinct.”

The Appellant respectfully disagrees that such teachings can be found in the cited paragraph. To begin with, there is no teaching that the requestor (user  
10 10) involves himself in another meeting while waiting for the other target to conference in. The Examiner does not explain where in the cited paragraph this teaching can be found. The Appellant asserts that all that is taught is that the user 10 may “send a request ... to initiate two calls ... and conference the two calls” (col. 7 lines 50-53). Vardi further provides that “[t]he user 10 typically can  
15 configure its client software to send the telephone numbers” (col. 7 lines 54-55). The conference call can be “with more than one user” (col. 7 lines 58-59) and “may additionally indicate if [the] conference call is to be tried immediately ... or tried only when all the telephone numbers ... are known to be available” (col. 7 lines 59-64). “User 10 may also initiate a call back” and “indicate if [the] call back  
20 is to be tried immediately or tried only when the telephone number with which the call back is concerned is known to be available” (col. 7 line 65 – col. 8 line 4). The Appellant fails to see any teaching about what the user 10 does while waiting, let alone involving himself in another meeting, as alleged by the



Examiner. Although multiple alternatives for achieving a teleconference are described, each alternative results in a single teleconference in Vardi.

Similarly, the Examiner asserts that “[a]s the parties are different and the  
5 meeting occurs at a different time, the meeting is distinct.” Starting with the parties, Vardi teaches user 10, user 12, and a “call with more than one user” (col. 7 lines 57-59), but never teaches or suggests that these are parties to more than the one teleconference. It is unclear, therefore, how “the parties are different.” It is also unclear how “the meeting occurs at a different time.” If the Examiner is  
10 here suggesting that because the time of the meeting depends on factors such as the availability of other users, and therefore the timing of the meeting is uncertain, the Examiner is reminded that it’s still only one meeting. The meeting cannot be distinct from itself. It should be apparent that the Examiner has not properly rebutted the Appellant’s arguments in the Appeal Brief.

15

The Appellant also now asserts that the Examiner’s motivation to add the teaching of Vardi to the previously proposed combination of Gisby and Yacenda does not relate to the proposed modification. As proposed, the combination of Gisby and Yacenda would add the call back feature of Yacenda to Gisby. The  
20 Examiner here proposes to further add from Vardi “to allow the requester to be a target in another meeting request” and the motivation is “to allow the requester to have greater control over the handling and routing of their calls.” (Examiner’s Answer page 18). The Board is reminded that this exact same motivation was

floated as justifying a modification of Gisby according to the teaching of Vaois, and here it is again used as a justification for combining a teach of Vardi with a combination of Gisby with Yacenda. Further, the Examiner has not indicated how allowing the requester to be a target in another meeting request supposedly  
5 provides the requester with greater control over “handling” and “routing.”

**whether the art cited by the Examiner includes all the limitations of  
Claim 94, specifically “*wherein the requestor R-A participates  
in another distinct realtime meeting*”**

10

In response to the rejection of claim 94, the Appellant suggested that perhaps the Examiner was considering a meeting between user 10 and another user while waiting for a third user to join in as being a first meeting, and after the third user joins the Examiner was considering the meeting to be a second  
15 meeting. The Appellant disagreed but noted that even if that were a reasonable interpretation, the two meetings would not be distinct. In rebuttal, the Examiner makes the same argument for distinctness refuted above with respect to claim 92. Again, in Vardi there is only one meeting, and it cannot be distinct from itself.

20

For at least these reasons, the text cited by the Examiner does not teach all of the limitations of Claim 94, and the Examiner has failed to provide a *prima facie* case for the rejection of Claim 94.

### Conclusion

In view of the above remarks, the pending claims in this application are believed to be in condition for allowance.

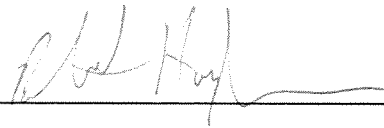
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Respectfully submitted,

Bradley S. Templeton

Date: May 7, 2009

By: \_\_\_\_\_



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Robert Hayden, Reg. No. 42,645  
Peters Verny, LLP  
425 Sherman Ave., Suite 230  
Palo Alto, CA 94306

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